

Remarks

Claims 1-46 are examined.

Claim Rejections – 35 USC §103

Claims 1-8, 10, 13, and 46 over Enyart and Coleman

Claims 1-8, 10, 13, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438). In this rejection, the Examiner substantially repeats his previous rejection in the Office Action of May 8, 2009 (“Previous Office Action”). In response to the Previous Office Action, Applicant explains in the Amendment of August 10, 2009 (“Previous Amendment”) that Claim 1 recites “a transaction tracking service which tracks registration messages received by each subscriber at one or more of the subscriber’s electronic addresses included in the subscriber profile database.” Registration messages received are typically sent to subscriber by email after the subscriber has actually registered at a particular service or vendor, and are not limited to the subscription service that operates the transaction tracking service. Applicant explains that the registration messages document actual interests or purchase habits of the subscriber, more than any questionnaire (e.g., Coleman’s) may be able to collect from the subscriber and thus, as explained in Applicant’s Specification, at page 10, lines 14-22, tracking such information provides particularly valuable to potential advertisers.

In response to Applicant’s comments, in the present Office Action, the Examiner first requests a clarification:

The Examiner respectfully requests clarification of this remark. It is not clear whether the claimed invention is tracking the registration process itself, or the subsequent exchange of information between the buyer and seller after the registration has been completed.

Applicant respectfully clarifies, as Claim 1 recites a “transaction tracking service which detects registration messages received by each subscriber at one or more of the subscriber’s electronic addresses included in the subscriber profile database,” the transaction tracking service is concerned with registration messages. Such registration messages are

typically sent in one of the latter steps of a transaction. For example, when a user registers with an on-line shopping website, the website server would send to a registration message to the user at the user specified email address, as part of a security step in the transaction process. Often, a link to a security page is embedded in the registration message. The user is required to click on the link to allow the vendor to verify that the provided email address belongs to the user providing the email address. The inventor of the present Application recognizes that the subscriber's registration with the on-line shopping website is a reliable indicator (and valuable knowledge) of the subscriber's interest in the kind of goods sold in that on-line website.

The Examiner continues:

Coleman Paragraph 97 disclosed wherein the potential purchasers are required to post an indication of purchaser interest in that offer to sign up for the deal. Coleman Paragraph 108 disclosed wherein only profiles having certain criteria are provided to the advertisers. The Examiner notes that the profile information regarding the potential purchaser is only available for presentation to other potential advertisers after the potential purchaser has actually registered to receive an advertisement.

The Examiner notes that Coleman is able to track messages received after the registration process because Coleman Paragraph 72 disclosed updating of profiles via email. Thus Coleman disclosed *registration messages received are typically sent to subscriber by email after the subscriber has actually registered at a particular service or vendor.* Furthermore Coleman Paragraph 72 is able to track transactions effected by the registered user through entities other than the system proprietor. Thus Coleman disclosed wherein *registration messages are not limited to the subscription service that operates the transaction tracking service.*

Applicant respectfully submits that the Examiner is mistaken. The fact that "potential purchaser is only available for presentation to other potential advertisers after the potential purchaser has actually registered to receive an advertisement" is not relevant to a "transaction tracking service which detects registration messages received at by each subscriber at one or more of the subscriber's electronic addresses included in the subscriber profile database." In fact, as Coleman's "system proprietor" is already informed of the potential purchaser's

interest directly in its registration process, there is no need in Coleman's system to track the system proprietor's own registration messages to the potential purchasers.

Furthermore, contrary to the Examiner's contention above, Coleman's paragraph [0072] does not teach tracking of registration messages. When a subscriber in Coleman updates its profile via email, such a subscriber would send the update to an email address of the "system proprietor." Such an email would not be a "[registration message] received by each subscriber at one or more of the subscriber's electronic addresses."

As to sources of outside information accessed by Coleman's system proprietor, Coleman's paragraph [0072] never once discloses that the information may be derived from "registration messages received by each subscriber at one or more of the subscriber's electronic addresses":

... The registered user's profile may also be updated by receiving transaction information from transactions effected by the registered user through entities other than the system proprietor of the present invention. In one embodiment, for instance, a registered user may provide access to credit card databases that would allow the registered user's profile to be updated. The act of updating may also involve gathering additional information about the potential purchaser from outside information sources after getting permission from the potential purchaser to do so. Information could be gathered from various online sources, credit bureaus, government databases, credit card companies, and any other information providers.

(Coleman, at paragraph [0072])

The Examiner further argues:

The Examiner notes that each potential purchaser is required to register in order to be recognized as such. Furthermore Coleman disclosed a potential user signing up for a deal which is equivalent to a registration process. Since Coleman involves updating profiles with new information regarding the said deals, wherein the new information is captured during the sign-up process (*'registration'*) then Coleman disclosed tracking responses to registration messages.

Once again, the Examiner is mistaken. According to the Examiner's arguments above, Coleman's user updates its profile by providing new information from the user to the system proprietor during the registration process. Therefore, Coleman does not teach or suggest

tracking "registration messages received by each subscriber at one or more of the subscriber's electronic addresses." Such registration messages cannot be useful for Coleman's purpose, as such registration messages represent information that is sent to the user from the system, not information that is sent from the subscriber to the system.

Therefore, Applicant respectfully submits that the Examiner's Coleman-based arguments against Claim 1 results from an erroneous understanding of Claim 1. Nevertheless, to more clearly point out and distinctly claim Applicant's invention, Applicant has amended Claim 1 to recite that the information regarding Applicant's on-line activities are derived specifically from the registration messages or order confirmation messages detected:

1. A system comprising:

a subscriber profile database provided in a computer readable medium including electronic addresses and biographical and affinity information of subscribers to the system;

a transaction tracking service which detects registration messages or confirmation messages received by each subscriber at one or more of the subscriber's electronic addresses included in the subscriber profile database and which extracts from the detected registration messages or confirmation messages information regarding the subscriber's on-line activities;
and

one or more search engines which access the transaction tracking service and the subscriber profile database; wherein in response to a query for electronic addresses, one of the search engines retrieves from the subscriber profile database electronic addresses of selected subscribers based on a search criterion selecting a specified biographical or affinity profile which includes the information regarding the subscriber's on-line activities.

(emphasis added)

Therefore, Applicant respectfully submits that Claim 1 and dependent Claims 2-6, 8, 10, 13 and 46 are each patentable over the combined teachings of Enyart and Coleman. Reconsideration and allowance of Claims 1-6, 8, 10, 13 and 46 are therefore requested.

Claim 11 over Enyart, Coleman, and Law

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) further in view of Law (US Publication 20060229934).

As Claim 11 depends from Claim 1, Claim 11 is patentable over the combined teachings of Enyart and Coleman for the reasons already stated above. As the Examiner cites Law for merely teaching forwarding of email, Law does not cure the deficiencies of Enyart and Coleman. Thus, Claim 11 is patentable over the combined teachings of Enyart, Coleman, and Law. Reconsideration and allowance of Claim 11 are therefore requested.

Claim 12 over Enyart, Coleman, Law, and Kubic

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) further in view of Law (US Publication 20060229934) further in view of Kubic (US Patent 6959324).

As Claim 12 depends from Claim 1, Claim 12 is patentable over the combined teachings of Enyart, Coleman, and Law for the reasons already stated above. As the Examiner cites Kubic merely for disclosing probe messages, Kubic does not cure the deficiencies of Enyart, Coleman and Law. Thus, Claim 12 is patentable over the combined teachings of Enyart, Coleman, Law, and Kubic. Reconsideration and allowance of Claim 12 are therefore requested.

Claims 14-21, 24-26, 31-33, 37-45 over Enyart, Coleman, and Goodwin

Claims 14-21, 24-26, 31-33, 37-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) further in view of Goodwin (US Publication 2003/0163485).

As set forth above, Claim 1, from which Claims 14-21, 24-26, 31-33, 37-45 depend, is patentable over Enyart and Coleman. As the Examiner cites Goodwin merely for teaching information stored in a database, Goodwin does not cure the deficiency of Enyart and Coleman. Therefore, dependent Claims 14-21, 24-26, 31-33, 37-45 are patentable over the combined teachings of Enyart, Coleman, and Goodwin. Reconsideration and allowance of Claims 14-21, 24-26, 31-33, 37-45 are therefore requested.

Claims 22-23 over Enyart, Coleman, Goodwin, and Fratkina

Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) further in view of Goodwin (US Publication 2003/0163485) in view of Fratkina (US Pub. 2005/0055321).

As Claims 22-23 depend from Claim 1, Claims 22-23 are patentable over Enyart, Coleman, and Goodwin for the reasons stated above. As the Examiner cites Fratkina merely for teaching a frequently asked questions database, Fratkina does not cure the deficiencies of Enyart, Coleman and Goodwin. Thus, Claim 1 and dependent Claims 22-23 are patentable over the combined teachings of Enyart, Coleman, Goodwin, and Fratkina. Reconsideration and allowance of Claims 22-23 are therefore requested.

Claim 34 over Enyart, Coleman, Goodwin, and Karamchedu

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) further in view of Goodwin (US Publication 2003/0163485) further in view of Karamchedu (US Pub. 2004/0201625).

Claim 34 depends from Claim 1, thus is patentable over Enyart, Coleman, and Goodwin combined for the reasons stated above. As the Examiner cites Karamchedu for merely teaching a daily limit on processing of certain emails, Karamchedu does not cure the deficiencies of Enyart, Coleman and Goodwin. Claim 34 is therefore patentable over the combined teachings of Enyart, Coleman, Goodwin, and Karamchedu. Reconsideration and allowance of Claim 34 are therefore requested.

Claims 27-30 over Enyart, Coleman, Goodwin, and Moskowitz

Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) further in view of Goodwin (US Publication 2003/0163485) further in view of Moskowitz (US Patent 7280982).

As Claims 27-30 depend from Claim 1, Claims 27-30 are patentable over Enyart, Coleman, and Goodwin combined for the reasons stated above. As the Examiner cites Moskowitz for merely teaching certain mailbox services, Moskowitz does not cure the deficiencies in the teachings of Enyart, Coleman, and Goodwin. Thus, dependent Claims 27-30 are patentable over the combined teachings of Enyart, Coleman, Goodwin, and Moskowitz. Reconsideration and allowance of Claims 27-30 are therefore requested.

Claim 35 over Enyart, Coleman, and Moskowitz

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) further in view of Moskowitz (US Patent 7280982).

As Claim 35 depends from Claim 1, Claim 35 is patentable over Enyart and Coleman. As the Examiner cites Moskowitz merely for teaching deferring forwarding a message until a service is paid, Moskowitz does not cure the deficiencies of Enyart and Coleman. Thus, Claim 35 is patentable over the combined teachings of Enyart, Coleman, and Moskowitz. Reconsideration and allowance of Claim 1 are therefore requested.

Claim 9 over Enyart, Coleman, and Sweeney

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) further in view of Sweeney (US Publication 2005/0004837).

As Claim 9 depends from Claim 1, Claim 9 is patentable over Enyart and Coleman for the reasons stated above. As the Examiner cites Sweeney merely for teaching specifying a number of electronic addresses based on the content of messages to be received, Sweeney does not cure the deficiencies of Enyart and Coleman. Thus, dependent Claim 9 is patentable over the combined teachings of Enyart, Coleman, and Sweeney. Reconsideration and allowance of Claim 9 are therefore requested.

Claim 36 over Enyart, Coleman, Goodwin, and Sweeney

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438) in view of

Goodwin (US Publication 2003/0163485) further in view of Sweeney (US Publication 2005/0004837).

As Claim 36 depends from Claim 1, Claim 36 is patentable over the combined teachings of Enyart, Coleman, Goodwin. As the Examiner cites Sweeney merely for teaching redirecting email messages of advertising interest, Sweeney does not cure the deficiencies of Enyart, Coleman and Goodwin. Thus, Claim 36 is patentable over Enyart, Coleman, Goodwin, and Sweeney for at least the same reason as Claim 1. Reconsideration and allowance of Claim 36 are therefore requested.

Conclusion

Therefore Applicant requests reconsideration and allowance for Claims 1-46.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 08-1394 for any matter in connection with this response, including any fee for extension of time and/or fee for additional claims, which may be required.

CERTIFICATE OF EFS-WEB TRANSMISSION

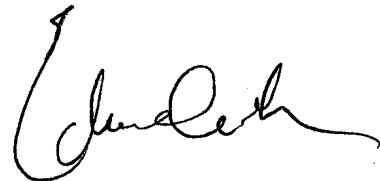
Certificate of Transmission: I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office (USPTO) via the USPTO's EFS-Web electronic filing system on January 27, 2010.

Typed or printed name of person signing this certificate:

Edward C. Kwok

Signature: _____

Respectfully submitted,



Edward C. Kwok
Attorney for Applicant(s)
Reg. No. 33,938

Haynes and Boone, LLP
2033 Gateway Place, Suite 400
San Jose, CA 95110
Tel: 408-660-4120
Fax: 214-200-0853